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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,392	03/29/2001	Nathaniel P. Langford	54493USA3C	3598

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EXAMINER

EGWIM, KELECHI CHIDI

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 03/07/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/821,392

Applicant(s)

LANGFORD, NATHANIEL P.

Examiner

Dr. Kelechi C. Egwim

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 49-65 is/are pending in the application.
- 4a) Of the above claim(s) 50-65 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Newly submitted claims 50-65 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The originally elected invention, represented by claim 49, is to a composition that is "initially paste-like", while claims 50-65 are to a composition that is initially in a "wet state".

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 50-65 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claim 49 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, 35 U.S.C. 103(a) as being unpatentable over Kaplan, Patel or Trmata, for reasons cited in the previous Office action.

Response to Arguments

4. Applicant's arguments with respect to Cole, Struss et al., Williams, Wakabayashi et al., Kono et al., or Kondrats are moot as the claims rejected by the references have been cancelled.

5. Applicant's arguments filed 1/8/03 have been fully considered but they are not persuasive.

6. Regarding claim 49:

In col. 2, lines 35-38, col. 3, lines 13-25, col. 5, lines 32-64 and col. 6, lines 31-39, Kaplan teaches a joint compound comprising a calcium carbonate filler, an acrylate binder, and from 0.10 to 0.20% of a surfactant.

Since the compound of is "useful", it is deemed to contain enough water to be "useful".

In col. 1, lines 7-11, col. 2, lines 15-33, col. 3, lines 55-64, col. 7, lines 12-16, col. 8, Table I and II, and col. 9, lines 35-44, Patel teaches a joint compound comprising:

- a) 1 to 100% of a filler,
- b) 1 to 4 % of latex binder material,
- c) 20 to 37% of water, and
- d) 0.1 to 50% of wetting agents.

In page 2, lines 9-16 and page 3, lines 25-30, Trmata teaches a stucco composition for repairing wall material, comprising:

- a) 35 to 55% of calcium carbonate,
 - b) 15 to 30 % of binder material,
 - c) 15 to 30% of water, and
 - d) 3 to 30% of linseed oil.
-

This is where each of these reference, individually, teach “essentially the same invention” as the presently claimed invention. The surfactant in Kaplan, the wetting agent in Patel and the linseed oil in Trmata, each represent dust-reducing additives as defined by applicant (see page 8, lines 10-16 in the present spec.). These additive are already taught to be present in prior art setting-type compounds, in the claimed amounts.

Contrary to applicant assertions, if applicant chooses to prove that the compounds in these reference would not produce the same dust reduction, Applicant **can** perform a one-to-one comparison between compounds within the scope of applicant's claims and compounds produced in each of the three references, including the additives understood by the Examiner to be consistent with “dust reducing additives” as defined by applicant, in the amounts taught by the prior art.

In re Fitzgerald et al. is still believed to be apposite, the rejections are maintained and **THIS ACTION IS MADE FINAL**. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kelechi C. Egwim whose telephone number is (703) 306-5701. The examiner can normally be reached on M-T (7:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703) 308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.



KCE
March 5, 2003